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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/936,538   | 09/13/2001  | Seiichi Tagawa       | 6404-03WOUS         | 7147             |
| 7590   | 12/09/2004  |                      | EXAMINER            |                  |
| Donald K Huber<br>McCormick Paulding & Huber<br>CityPlace II<br>185 Asylum Street<br>Hartford, CT 06103-4102 |             |                      | RHEE, JANE J        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1772                |                  |
| DATE MAILED: 12/09/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                        |                        |                     |
|------------------------|------------------------|---------------------|
| <b>Advisory Action</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                        | 09/936,538             | TAGAWA ET AL.       |
|                        | <b>Examiner</b>        | <b>Art Unit</b>     |
|                        | Jane Rhee              | 1772                |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 12 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.
3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 8 and 9.

Claim(s) withdrawn from consideration: none.

8.  The drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_

## ADVISORY ACTION

### *Acknowledgement of Applicant's Amendment*

1. The proposed amendments will not be entered because they raise new issue that would require further consideration and/or search. The new issue is that the surface roughness in at least one of a metal surface adhering to the polymer elastic body in the hub and a metal surface adhering to the polymer elastic body in the inertia mass body is within "a range of 15-50umRz" (JIS B0601). Furthermore, the newly claimed range of "15-50umRz" raises an issue of new matter. The specification disclosed in page 8 line 14 that "the inertia mass body is within a range of 5-50umRz". Therefore, there is no apparent basis for amending the range in the original disclosure for "15-50umRz." It appears that the applicant is introducing the new range "15-50umRz" to overcome the Kurashiki's range about 5umRz. Thus the newly claimed range "15-50umRz" constituted the issue of new matter.

### *Response to Arguments*

2. Applicant's arguments filed 11/12/2004 have been fully considered but they are not persuasive.

In response to applicant's argument Sieveres and Kurashiki fail to teach the surface roughness in the range of 15-50umRz, applicant's argument is directed to the new issue that was not considered before and therefore is moot since the new issue would require further consideration and search. Furthermore, the newly claimed range constitute a new matter as described above.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee

~~November 29, 2004~~

December 8,

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/8/04